

REMARKS

Comments

Claims 52-75 are currently pending. Claim 52 has been amended to recite an additional claim limitation. This amendment is supported in the application by Figs. 8-10 and the corresponding text. Additionally, claim 60 has been rewritten in independent form.

35 U.S.C. §102

According to the Office Action claims 52, 61, 65-68, 70, 74, and 75 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,116,198 to Roos.

Additionally, claims 52, 55-58, 61, 63, 65, 67-70 and 74 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Nos. 4,381,007 to Doss.

Applicant has amended the pending claims to recite an additional limitation in claim 52 that is not described or suggested in Roos or Doss. In particular, claim 52 requires, amongst other things, that the active electrode is arranged laterally on the shaft. This is a meaningful claim limitation because it allows for a surgeon to remove or treat tissue laterally while moving the shaft proximally and distally through an endoscope. This is important in arthroscopic procedures, a procedure that is not discussed in either Roos or Doss.

Indeed, there is no reason to provide or arrange an electrode on a shaft of the Ross and Doss devices because these patents are directed to different surgical procedures. Additionally, arranging the electrode onto a lateral surface in the Roos and Doss devices may inhibit the procedures taught in Roos and Doss and is therefore not a suitable modification of such devices.

Based on the foregoing, reconsideration and withdrawal of the rejections are requested.

35 U.S.C. §103

For the reasons discussed above in connection with the Section 102 rejections, Applicants submit that the subject claims are not described or suggested by any combination of Roos and Doss.

Additionally, Knowlton does not add anything that addresses the above mentioned deficiencies. Knowlton provides a membrane device for contraction of collagen without ablation. In stark contrast, the present invention removes tissue using high frequency voltage gradient between an active and return electrode.

Based on the foregoing, withdrawal of this rejection is requested.

Double Patenting

Claims 52-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-62 of U.S. Patent No. 5,891,095.

Applicants agree to submit a proper terminal disclaimer upon an indication that the subject claims are otherwise in allowable form.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,



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